

REMARKS

Claims 1, 3-6, 8-11, 13-17, and 19-23 are pending in the application. Claims 1, 6, 11, and 17 are independent claims. Claims have been rejected under 35 U.S.C. 112, First Paragraph, under 35 U.S.C. 101, and under 35 U.S.C. 103(a). Those rejections are respectfully traversed and reconsideration is requested.

Statement of Substance of Examiner Interview

Applicants' Attorney thanks Examiner Swearingen for a helpful telephonic interview on October 25, 2007 with the undersigned regarding the pending case.

Regarding the rejections under 35 U.S.C. 112, First Paragraph, the present application, U.S. Application No. 09/821,908 (now U.S. Patent No. 6,983,282, and incorporated by reference into the present application) and U.S. Application No. 09/910,169 (now U.S. Patent No. 7,065,483, and incorporated by reference into the present application) were discussed. During the interview, Applicants identified to the Examiner where in the applications support for various claims elements could be found. Those sections of the applications are cited below in the section regarding the rejections under 35 U.S.C. 112, First Paragraph.

Regarding the rejections under 35 U.S.C. 101, Applicants explained that the present invention does not fit into any of the definitions of "spam" provided in the Office Action, and that the invention has a legitimate, useful purpose as required by 35 U.S.C. 101.

Regarding the rejections under 35 U.S.C. 103(a), Applicants explained how the disclosure of cited reference "Cranor" does not explicitly disclose the details of how email addresses are harvested from the Internet, but only that "spamming" was taking place in at least 1998, that is, simply disclosing that a method took place does not teach how to perform the elements of that method. Applicants also explained that contrary to the assertion made in the Office Action, the Applicants have argued that the combination of the cited references do not anticipate or make obvious the claimed invention, and have not merely argued the references individually. Statements made during the interview regarding each of the above rejections are included and expanded upon in the sections below.

Rejections under 35 U.S.C. 112, First Paragraph

Claims 1, 6, 15, and 22 have been rejected under 35 U.S.C. 112, First Paragraph, as failing to comply with the written description requirement.

The Office Action states that the claimed element of “*using the deduced information in a manner omitting randomness*” is not described in the Applicants’ specification. However, support for using the deduced information in a manner omitting randomness is found on at least page 25, line 15 – page 26, line 4, and Fig. 3, reference numeral 107 of the Applicants’ specification as originally filed, which describes an embodiment that constructs potential email addresses for a subject person by applying patterns and rules, which have been deduced from other information, to the name of the subject person. According to the embodiment, the patterns or rules are not randomly deduced, and are not randomly applied to the name of the subject person, thus, the claimed embodiment uses the deduced information in a manner omitting randomness when constructing the potential email addresses for the subject person. Moreover, Applicants respectfully remind the Examiner that “there is no *in haec verba* requirement” for claim amendments (*see* MPEP, section 2163) and that a mere “lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support” (*see* MPEP, section 2173.05(i)). Therefore, Claims 1, 6, 15, and 22 are believed to comply with the written description requirement.

Claims 1, 3-6, 8-11, 13-17, and 19-23 have been rejected under 35 U.S.C. 112, First Paragraph, as failing to comply with the enablement requirement.

In making the rejection, the Examiner applied the factors of *In re Wands*, 858 F.2d 731 (Fed. Cir. 1998) in determining whether one skilled in the art would be able to make or use the claimed invention without undue experimentation.

As discussed below with reference to each of the factors, it is believed that the Examiner has erred in his determination of non-enablement.

(A) *The Breadth of the Claims*

Applicants respectfully remind the Examiner that “[t]he examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.” *See* section 2164.08 of the MPEP. The Examiner’s

application of the factors of *In re Wands* to the Applicant's disclosure seems to analyze each claim limitation individually, and not the claim as a whole.

(B) The Nature of the Invention

The Examiner states that the invention is a "web crawler" that extracts email addresses of persons, creates possible email addresses, and tests the email addresses; however, the "web crawler" (or plurality thereof) is just one component of the invention, not the entire invention. While the "web crawler" component of the invention gathers information from web pages, other components of the claimed invention perform additional functionality, such as a post processor that creates and tests possible email addresses.

(C) The State of the Prior Art

The Examiner contends that the Applicants have somehow stated that the invention is well known in the art; however, the Applicants have made no such statement. Given the Examiner's apparent mistaken understanding of the nature of the invention (i.e., that the invention consisted solely of a "web crawler"), it may be that the Examiner misconstrued a statement regarding "web crawlers" as being known in the art to mean that the invention was well known in the art. Because the invention comprises more than just a "web crawler", the invention is not well known in the art.

The examiner further states that various elements of the claimed invention are not known in the prior art, which supports an argument in favor of novelty of the claimed invention, i.e., the claimed invention is not found in the prior art.

The Examiner also stated that testing email addresses for validity by sending an unsolicited email message is known in the art as "spamming"; however, according to the definition of "spam" provided by the Examiner at pages 2-3 of the Office Action at hand, simply sending an unsolicited email message is not considered "spam." Further arguments regarding the Examiner's definition of "spam" are presented below in the section concerning the rejections under 35 U.S.C. 101.

(D) The Level of One of Ordinary Skill

The Examiner states that one of ordinary skill in the art "is unaware of how to implement a device [that performs the limitations of the claimed invention]." It should be noted, however, that the test for enablement is whether one of ordinary skill in the art would be enabled to make or use the invention given the Applicant's disclosure, and not whether one of ordinary skill in the art would be aware of how to implement the invention in the absence of the Applicants' disclosure (*see* MPEP, section 2164). Furthermore, it should be noted that the Examiner's statements pertaining to one of ordinary skill in the art being unaware of how to implement the claimed invention support an argument in favor of non-obviousness of the claimed invention (i.e., the invention is not obvious to one of ordinary skill in the art if it is unknown to one of ordinary skill in the art how to implement the invention).

It is noted that the Examiner's definition of the level of ordinary skill in the art to which the present invention pertains is generally acceptable; however, it is also noted that one of ordinary skill in the art of databases and data processing may possess less than a Bachelor level degree (e.g., Associate level degree) and less than 3-5 years of industry experience.

(E) The Level of Predictability in the Art

The Examiner states that the networking art to which the invention pertains is predictable, which has the effect of lessening the amount of enabling information that must be explicitly disclosed in the Applicants' specification. According to section 2164.03 of the MPEP, "the more predictable the art is, the less information needs to be explicitly stated in the specification." It should also be noted that another, and more relevant, art to which the present invention pertains is the art of databases and data processing, which is also predictable.

(F) The Amount of Direction Provided by the Inventor

The Examiner states that there is no support for the Applicant's claimed manner of using deduced information that omits randomness; however, as presented above, support for using the deduced information in a manner omitting randomness is either explicitly or implicitly found in the Applicants' specification.

The Examiner also states that the Applicants have failed to give support for a "web crawler" used to obtain a working email address that is associated with a particular organization;

however, the Applicants provide explicit support for a “web crawler” in at least the Applicants’ related U.S. Application No. 09/821,908 (now U.S. Patent No. 6,983,282) and U.S. Application No. 60/221,750, pages 33-47; both of which were incorporated by reference into the present application. The information disclosed in the above applications are, therefore, part of the present disclosure. Specifically, Fig. 2 of U.S. Application No. 09/821,908 and col. 6, line 41 – col.9, line 43 of the corresponding description describe in detail the operation of a “web crawler” of the present invention. As such, the present disclosure provides either explicit or implicit support for the functions and use of a “web crawler.” Furthermore, the description of a “web crawler” together with the disclosure in at least page 18, line 22 – page 19, line 11 of the Applicants’ specification gives support for the claimed obtaining of a working email address.

The Examiner also states that the Applicants fail to disclose how the database of the claimed invention has publicly available information; however, the Applicants disclose that the information stored in the database is retrieved from publicly available information on a network, such as the Internet (*see* Applicants’ specification, page 7, lines 7-25). Thus, while the Applicants’ database might not be publicly available, the information that is stored in the database is described as being publicly available because the information was obtained from publicly available sources. Therefore, because the Applicants disclose that the information was retrieved from publicly available sources, the Applicants’ disclose how one of ordinary skill in the art would provide a database storing publicly available information.

The Examiner also states that one of ordinary skill in the art is unaware of how to construct the “left side” of an email address (left of the “@”) according to the claimed invention in the absence of an example email address format that is “preprogrammed into” the invention, and states that the Applicants’ disclose no such “preprogrammed” email address format. The Applicant disclose, however, at least two methods for constructing an email address: 1) By obtaining a sample working email address associated with an organization, extracting an email format from the sample email address, and applying the email format to a subject person’s name (*see* Applicants’ specification, page 25, line 15 – page 26, line 4), and 2) by applying predefined common email address formats to the subject person’s name in the event that the above sample working email address cannot be obtained (*see* Applicants’ specification, page 26, lines 5-16). Specific examples of an email format for an organization are provided on page 25, lines 23-25 of

the Applicants' disclosure, and a specific example of an application of that format to a subject person's name to construct the "left side" of an email address is provided on page 26, lines 1-4 of the Applicants' disclosure. By providing specific examples of the application of an email format to a subject person's name, the Applicants enable one of ordinary skill to construct the "left side" of an email address. Therefore, contrary to the Examiner's assertion, the Applicants disclose how one of ordinary skill in the art would construct potential email addresses for a subject person (including how to construct the "left side" of an email address), disclose the use of predefined email formats in doing so, and provide examples of such predefined email formats.

The Examiner also states that one of ordinary skill in the art is unaware of how an email address format is detected by the invention to determine a generic email address format, which is also to say that determining an email address format in such a way is nonobvious. The Applicants', however, disclose how an email address format is detected by the invention to determine a generic email address format on at least page 25, lines 8-27 of the Applicants' specification, and provide specific examples of doing so.

The Examiner also states that one of ordinary skill in the art is unaware of how to merge a database with specific personal information into a format mirroring an email address format that could be used for constructing and testing email addresses. This is irrelevant, however, because no claim is directed towards determining an email address format by merging a database with specific personal information.

The Examiner also states that one of ordinary skill in the art is unaware of how a device can detect a name on a web page or press release, which is also to say that detecting a name on a web page or press release is nonobvious. The Applicants', however, disclose how a device can detect a name on a web page or press release in at least the Applicants' related U.S. Application No. 09/910,169 (now U.S. Patent No. 7,065,483) and U.S. Application No. 60/221,750, pages 48-65; both of which were incorporated by reference into the present application. The information disclosed in the above applications are, therefore, part of the present disclosure. Specifically, col. 8, line 31 – col. 9, line 47 of U.S. Application No. 09/910,169 describes the use of a number of text strings in detecting noun phrases within a block of text. As such, the present disclosure provides either explicit or implicit support for detecting a name on a web page or press release.

The Examiner also states that one of ordinary skill in the art is unaware of how to affiliate a specific email address with an organization, which is also to say that affiliating a specific email address with an organization is nonobvious. The Applicants', however, disclose how to affiliate an email address with an organization in at least the Applicants' related U.S. Application No. 09/910,169 (now U.S. Patent No. 7,065,483) and U.S. Application No. 60/221,750, pages 48-65; both of which were incorporated by reference into the present application. The information disclosed in the above applications are, therefore, part of the present disclosure. Specifically, col. 17, line 44 – col. 18, line 20 of U.S. Application No. 09/910,169 describe a technique for affiliating people, email addresses, and organizations. As such, the present disclosure provides either explicit or implicit support for affiliating a specific email address with an organization.

The Examiner asserts that the Applicants' specification does not disclose how to merge two records of the Applicants' database as claimed in Claim 11; however, a detailed description of how the present invention merges such records in the database is found on at least page 21, line 25 – page 25, line 3, and Fig. 4 of the Applicants' specification.

Also, contrary to another of the Examiner's assertions, the Applicants disclose how to use statistical rarity of an individual's name or title in determining whether to combine two records of the database in at least page 24, line 10 – page 25, line 3 of the Applicants' specification, and Fig. 4. For example, if two records of the database include a common name of "John Smith" and a common title of "Product Manager", it may be determined from the frequency of the name and the title in the database that both the name and the title occur frequently in the database and, thus, are not rare. In the case that the name and title are not rare, the records will not likely be merged. If, on the other hand, two records of the database include a common name of "John Smith" and a common title of "Patent Clerk", it may be determined from the frequency of the title in the database that the title does not occur frequently in the database and, thus, is rare. In this case, the records will likely be merged due to the rarity of the title "Patent Clerk" in the database. (See Applicants' specification, page 24, lines 10-22; and Fig. 4.) Thus, contrary to the Office Action at hand, the Applicants' specification does not fail to teach how statistical rarity of a person's name and title is used in determining whether to combine two records. It should also be noted that the Examiner has stated that the Patent Office (USPTO) is unaware of any prior art that teaches the use of statistical rarity of a person's name or title to determine whether two data

records are unique, further supporting a showing of the novelty and nonobviousness of Claims 13 and 20 of the present application, which are directed toward such use of statistical rarity.

The Examiner has also asserted that the Applicants could not provide support as to how a web page is identified as containing "information of interest;" however, the Applicants disclose the use of a "web crawler" that identifies such web pages. See Applicants' related U.S. Application No. 09/821,908 (now U.S. Patent No. 6,983,282) and U.S. Application No. 60/221,750, pages 33-47; both of which were incorporated by reference into the present application.

(G) The Existence of Working Examples

The Examiner states that the Applicant provided no working examples of the claimed invention; however, as defined in section 2164.02 of the MPEP, "[a] working example is based on work actually performed [while a] prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved." The disclosure of the present application is based on work actually performed, therefore, the embodiments described therein represent working examples.

Furthermore, Applicants respectfully remind the Examiner that "[w]hen considering the factors relating to a determination of non-enablement, if all the other factors point toward enablement, then the absence of working examples will not by itself render the invention non-enabled." (See MPEP, section 2164.02.)

(H) The Quantity of Experimentation Needed to Make or Use the Invention Based on the Content of the Disclosure

The Examiner asserts that the Applicants provide only a limited specification and that, therefore, one skilled in the art would be faced with undue experimentation in recreating the Applicants' claimed invention; however, as presented above, not only does the Applicant's specification (including disclosure incorporated by reference) provide ample support for the claimed invention, but the high level of predictability in the art (as stated by the Examiner) lessens the amount of enabling information that must be explicitly disclosed in the present application.

Because one of ordinary skill in the art would not be subject to undue experimentation to make or use the invention as claimed, Claims 1, 3-6, 8-11, 13-17, and 19-23 are believed to be enabled by the Applicants' disclosure.

As such, withdrawal of the rejections under 35 U.S.C. 112, First Paragraph, as to the written description and enablement requirements is respectfully requested.

Rejections under 35 U.S.C. 101

Claims 1, 3-6, 8-11, 13-17, and 19-23 have been rejected under 35 U.S.C. 101 as being directed toward non-statutory subject matter.

In addition to the reasons presented in responses to previous Office Actions, the following are reasons why the rejections under 35 U.S.C. 101 should be withdrawn.

The Examiner, on page 2 of the Office Action at hand, states that because it is believed that the present invention is in violation of the CAN-SPAM Act, that the invention is not statutory subject matter. This reasoning under 35 U.S.C. 101 is incorrect, because in order for an invention "[t]o violate § 101 the claimed device must be totally incapable of achieving a useful result." See *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992). Thus if an invention is suitable for a useful purpose, the invention satisfies the utility requirement of 35 U.S.C. 101. Because the present invention is useful for providing a database of contact information, the present invention is useful for a legitimate purpose. It should also be noted that the present application discloses both a method (i.e., a process) and a system (i.e., a machine), which are both statutory subject matter under 35 U.S.C. 101.

In addition, it is further submitted that the present invention is not in violation of the CAN-SPAM Act. The Examiner, in his response to the Applicants' previous arguments, relies on a definition of "spam" supplied by Microsoft's Computer Dictionary, Fifth Edition, in which the Examiner states that "spam" is defined as: 1) To distribute unwanted, unrequested mail widely on the Internet by posting a message to too many recipients or too many newsgroups; or 2) An unsolicited e-mail message sent to many recipients at one time, or a news article posted simultaneously to many newsgroups.

The test emails of the present invention fall under neither of these definitions, as they are only aimed at only a single recipient (the subject person), and only one of the test emails is

ultimately received by the single recipient. Though multiple email messages may be constructed, only one email address, if any, is a valid email address. Thus, there is only one recipient of the test email message of the present invention. Therefore, the test emails of the present invention cannot be sent widely to too many recipients or too many newsgroups, and fit neither of the definitions of "spam" from Microsoft's Computer Dictionary, Fifth Edition, as provided by the examiner.

The Examiner also defines "spam" as "an abuse of the Internet in order to distribute a message to a huge number of people at minimal cost ... or... an unsolicited e-mail message from a business or individual that seeks to sell the recipient something." As stated above, only one of the test emails of the present invention have an actual, if any, recipient. Thus the test emails are not distributed to a huge number of people. Furthermore, as stated in response to previous Office Actions, and as recited in the claims, the test email messages do not seek to sell the recipient something. Therefore, the email of the present invention falls under neither of the definitions of "spam" provided by the examiner.

As such, Claims 1, 3-6, 8-11, 13-17, and 19-23 are believed to be directed toward statutory subject matter. Withdrawal of the rejections under 35 U.S.C. 101 is respectfully requested.

Rejections under 35 U.S.C. 103(a)

Claims 1, 3-6, 8-11, 13-17, and 19-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cranor ("Spam!": Communications of the ACM, August 1998. Volume 4, Issue 8, pp.74-83).

As presented in a response to a previous Office Action, the Examiner stated that "Cranor failed to disclose a method of [creating spam by harvesting email addresses from the World Wide Web], but disclosed that [spamming] was taking place prior to the publication of the article in 1998." (See paragraph 20 of the current Office Action, which is substantially the same as the previous rejections under 103(a) over Cranor.) In response to the rejection, the Applicants pointed out that although Cranor discloses that a method for harvesting email addresses from the Web existed in 1998, Cranor did not teach or suggest all the claim limitations of the present

invention. In other words, simply stating that a method took place does not disclose or make obvious the intricate details of that method.

The Examiner responded in the current Office Action by defining "email harvesting" (mentioned by Cranor as existing in 1998) as consisting of a number of the elements of the Applicants' claimed invention, but without providing any support for the definition. The Examiner also provided another definition of "spam" as being the remaining limitations of the Applicants' claimed invention, but without providing any support for the new definition. It should be noted that the definition of "spam" provided by the Examiner in the rejections under 35 U.S.C. 103(a) is different than the definition of "spam" provided by the Examiner in the rejections under 35 U.S.C. 101.

Turning to Cranor, the statement regarding the existence of *"specialized software capable of sending 250,000 messages with forged headers per hour and harvesting email addresses from Usenet, the Web, and online services"* does not make obvious the claimed elements of 1) obtaining a working e-mail address of an organization (the e-mail address not being the e-mail address of a subject person of the organization), 2) deducing a format of e-mail addresses for the organization from the working e-mail address, 3) using the format to construct potential e-mail addresses for the subject person at the organization, and 4) verifying the potential e-mail addresses by sending test e-mail messages using the potential e-mail addresses to an e-mail server with the primary purpose of determining a response of the e-mail server.

Therefore, because Cranor still fails to disclose the elements of the claimed invention, Claims 1, 3-6, 8-11, 13-17, and 19-23 are believed to be novel and non-obvious over Cranor.

In response to the Applicants' arguments traversing the previous rejections under 35 U.S.C. 103(a) in the previous Office Action, the rejections being substantially the same as the rejections under 35 U.S.C. 103(a) in the current Office Action, the Examiner states that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of the references." Applicants agree with this general statement; however, in the response to the previous Office Action, the Applicants' explained in detail that upon combination of the references, the resultant combination does not teach or suggest the Applicants' claimed invention, and further explained that the references had been improperly combined. Thus, the Applicants did not merely argue the references individually. Therefore,

reconsideration is respectfully requested in view of the apparently mistaken notion that the Applicants merely argued the references individually. For the Examiner's convenience, the arguments presented in response to the previous Office Action are summarized below.

Claims 1, 3, 6, and 8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. Patent No. 6,377,936) in view of Miller (Online Search Secrets, 173-179) in view of Biliris (U.S. Pub. No. 2001/0009017).

Henrick is directed to a method for operating a computer network that enables merchandise and service providers to market their products to network users without invading the privacy of the user (*see* Henrick, col. 1, lines 32-36). Conversely, Miller is directed to searching for email addresses using an Internet service provider (*see* Miller, page 173), and Biliris is directed to a messaging system, and method of operation thereof, which supports combinations of directory and mailing list addressing mechanisms, provides the capability to specify intended message recipients using combinations of mailing list and directory information and does not require mailing lists to be explicitly enumerated (*see* Biliris, page 1, paragraph 9).

Applicants disagree that the combination of the three references renders the present invention obvious. In particular, the Office Action states that Henrick discloses the claimed element of *"providing a database storing publicly available information regarding people ... the database including for each person at least name of the person and the name of respective organization with which the person is currently associated."* Henrick, however, tracks customers' identities, as well as their likes and dislikes, while preserving the privacy of those customers. This information gathered by Henrick does not originate from publicly available sources, but instead is mined from the private actions of the customers (*see* Henrick, col. 3, lines 10-18). Therefore, unlike the present invention as claimed in independent Claims 1 and 6, Henrick does not store publicly available information. Likewise, neither Miller nor Biliris teaches or suggests how to provide a database storing publicly available information regarding people. It should be noted that while Miller discloses the existence of email directories, it does not teach or suggest how those directories are created.

Furthermore, the Office Action contends that Miller's disclosed techniques for finding email address information on the Internet cures the failure of Henrick to disclose what to do if email address information is missing from the database. Applicants disagree, however, as the

techniques taught by Miller do not coincide with that of the present invention as claimed in independent Claims 1 and 6. Miller simply discloses that a person's email address may be found using an email directory service or white/yellow page service, and provides, on page 175, a table that lists some of the more popular email directory websites and their corresponding URLs. Miller does not teach or suggest deducing an email address format of an organization, and using the email format to construct a potential email for a subject person. Therefore, unlike the present invention as claimed in Claims 1 and 6, Miller merely discloses a technique for finding an email address using an email directory service, and does not disclose or suggest how these email directory websites obtain an email address for retrieval by a user of the particular service. Likewise, neither Henrick nor Biliris teaches or suggests how to deduce an email address format of an organization, and then use the email format to construct a potential email for a subject person.

Furthermore, Applicants disagree with the Examiner's statement that it would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Henrick, Miller, and Biliris for the purpose of sending messages to recipients without an explicitly enumerated mailing list. The Examiner supported his conclusion by stating that Henrick gives motivation for the combination by stating that a user who might be interested in receiving information is reluctant to provide information to business. However, rather than providing a motivation for the combination, Henrick teaches away from the combination, as Henrick teaches the preservation of its customers' privacy, and requires that a customer assent to the dissemination of any of the customer's personal information. Therefore, one skilled in the art would not be motivated to combine any prior art with Henrick, which requires consent before releasing a customer's private information.

Therefore, independent Claims 1 and 6 are believed to be in condition for allowance. Claims 3 and 8 are dependent on independent Claims 1 or 6, thus, Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons as presented above for independent Claims 1 and 6.

Claims 4 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris in further view of Mills (Australian Patent Abstract No. AU-A-53031/98). Claims 4 and 9 are dependent on independent Claims 1 or 6 and, thus,

Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons as presented above for independent Claims 1 and 6.

Claims 5 and 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris in view of Mills in further view of Barroux (U.S. Patent No. 5,923,850). Claims 5 and 10 are indirectly dependent on independent Claims 1 or 6 and, thus, Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons as presented above for independent Claims 1 and 6.

Claims 11, 13, 17, 19, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight (U.S. Patent No. 6,493,703) in view of Feridun (U.S. Patent No. 6,336,139).

The Office Action states that the Knight reference gives motivation for the combination of the above references by stating that not distinguishing between subject areas (changes in a person) results in frustration to the user. This statement is correct insofar as it presents a problem solved by the invention disclosed by Knight. Applicants, however, do not agree that the statement provides a suggestion or motivation to combine Knight with Feridun, as Knight and Feridun disclose different systems to solve different problems. Knight discloses an electronic message board system that classifies content from discussion boards or newsgroups to substantially eliminate the need for manual, cumbersome review of individual messages throughout dozens of new groups with non-illuminating identifiers. Feridun, on the other hand, discloses a method of event correlation to manage events generated by managed computers in a large and complex distributed computer network. One of ordinary skill in the art faced with the problem of resolving two database records of potentially the same person would not look to event correlation as is disclosed in Feridun.

In addition, Knight and Feridun, either separately or in combination, do not teach or suggest the elements of independent Claims 11 and 17. First, Knight and Feridun, either separately or in combination, do not teach or suggest comparing the name of a person and another separate piece of information indicated in a first record with the name of a person and another separate piece of information indicated in a second record as claimed in independent Claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups and Feridun correlates events generated by distributed computers; the combination of which does not

teach or suggest the claimed invention. Second, Knight and Feridun, either separately or in combination, do not teach or suggest the further step of merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in independent Claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups, and Feridun aggregates correlated events; the combination of which does not teach or suggest the claimed invention.

Because neither Knight, Feridun, nor the knowledge generally available to one of ordinary skill in the art provides any suggestion or motivation to combine the teachings of Knight and Feridun, and because Knight and Feridun, either alone or in combination, do not teach, suggest, or otherwise make obvious the elements of independent Claim 17 (“comparing the name of a person indicated in a first record with the name of a person indicated in a second record; determining whether another two separate pieces of information between the first and second records are reasonably the same if the name comparing results in a match; merging the first and second records into one record when ... the other two separate pieces of information ... [are] reasonably the same”), Applicants respectfully submit that Claim 17 is believed to be in condition for allowance. Independent Claim 11 includes similar elements as Claim 17, thus, Applicants respectfully submit that Claim 11 is also believed to be in condition for allowance.

Claims 13, 19, and 20 are either directly or indirectly dependent on independent Claims 11 or 17, thus, Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons as presented above for independent Claims 11 and 17.

Claims 14 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Henrick. Claims 14 and 21 are dependent on independent Claims 11 or 17, thus, Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons as presented above for independent Claims 11 and 17.

Claims 15-16 and 22-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Henrick in view of Biliris. Dependent Claims 15-16 and 22-23 are directly or indirectly dependent on independent Claims 11 or 17, thus, Applicants respectfully submit that these claims are novel and nonobvious over the cited art for at least the same reasons

as presented above for independent Claims 11 and 17. Therefore, the 35 U.S.C. 103(a) rejections of Claims 1, 3-6, 8-11, 13-17, and 19-23 are believed to be overcome.

Accordingly, the present invention as claimed is believed to comply with the written description and enablement requirements, is believed to be directed toward statutory subject matter, and is not believed to be anticipated or made obvious by the cited or prior art.

Withdrawal of the rejections under 35 U.S.C. 112, First Paragraph, the rejections under 35 U.S.C. 101, and the rejections under 35 U.S.C. 103(a) is respectfully requested. Accordingly, acceptance of Claims 1, 3-6, 8-11, 13-17, and 19-23 is also respectfully requested.

CONCLUSION

In view of the above remarks, it is believed that all claims (Claims 1, 3-6, 8-11, 13-17, and 19-23) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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